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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER YU, GINA C	
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/018,769  
Filing Date: December 21, 2001  
Appellant(s): DECOSTER ET AL.

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MARK SWEET  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed on March 29, 2010 appealing from the Office action mailed May 19, 2009.

**(1) Real Party in Interest**

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The following is a list of claims that are rejected and pending in the application:

Claims 18, 20-28, 30-51 are pending; all pending claims are rejected.

**(4) Status of Amendments After Final**

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

**(5) Summary of Claimed Subject Matter**

The examiner has no comment on the summary of claimed subject matter contained in the brief.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN

REJECTIONS.” New grounds of rejection (if any) are provided under the subheading “NEW GROUNDS OF REJECTION.”

**(7) Claims Appendix**

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant’s brief.

**(8) Evidence Relied Upon**

WO 99/13830	MITSUMATSU et al.	03-1999
WO 98/03155	SEBAG et al.	01-1998
JP 64-9916 A	OSHIMA et al.	01-1989
US 6162423	SEBAG et al.	12-2000

Oshima, T. “Shampoo Composition”, JP41009916A, January 13, 1989, Abstract.

Oshima, T. "Shampoo Composition", JP 64009916, January 13, 1989, Full translation of JP 64-9916 A (PTO-0425).

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

**Claims 18, 20-28, and 30-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsumatsu et al. (WO 99/13830) (“Mitsumatsu”) in view of Oshima (JP401009916A) and Sebag et al. (WO 98/03155) (“Sebag”).**

Mitsumatsu teaches shampoo formulations comprising trizole, an optical brightener, and either stearyl (C18) alcohol or behenyl (C22) alcohol. See Examples 3-5. Deterative surfactants such as ammonium lauryl sulfate and cocamidopropylbetaine are used within the claimed

amount. See instant claims 37-39. Conditioning agents such as silicone emulsion are used. See instant claims 40-44. See p. 45, lines 9 – 14 for the method of use. See instant claims 49-51.

While Mitsumatsu suggests using cetyl alcohol, stearyl, and behenyl alcohol either individually or as a mixture in p. 24, lines 16 – 20, the reference does not provide a specific example which concurrently uses stearyl alcohol and behenyl alcohol in the ratio as required by instant claim 18.

Oshima teaches a shampoo containing anionic and/or ampholytic surfactant and stearyl alcohol and behenyl alcohol as essential components, wherein the amounts of stearyl (C18) alcohol and behenyl (C22) alcohol are 0.5-5 [sic] wt % and 0.75-7.5 wt %, respectively, and the weight ratio of the alcohols is *1:1.15-1:4.5*. See English abstract; instant claim 18. The shampoo is said to have “beautiful appearance and excellent storage stability, is capable of imparting pearl luster to hair and has excellent hair-conditioning effect”.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify teaching of Mitsumatsu by using stearyl and behenyl alcohols in the weight ratio as motivated by Oshima, because 1) Mitsumatsu suggests using stearyl and behenyl alcohols within the weight amount which overlaps with Oshima; and 2) Oshima teaches the combination of the two fatty alcohols in a specific ratio in a shampoo formulation which is stable and imparts excellent hair conditioning effect. The skilled artisan would have had a reasonable expectation of successfully producing a stable shampoo formulation.

Mitsumatsu and Oshima fails to teach the opacifier/pearlescent recited in claims 18 and 20--25.

Sebag teaches hair washing and conditioning compositions comprising a dialkyl ether of formula (II) in instant claim 22, and preferably distearyl ether. See English equivalent of Sebag, US 6162423, col. 2, lines 26 – 53; col. 1, lines 4- 66. The reference teaches that the use of at least one fatty dialkyl ether used in the instant invention renders a washing foaming compositions having insoluble silicones and surfactants, pearlescent effect, good homogeneity, and improved stability while maintaining foaming power. See Example 1, which comprises stearyl alcohol, suggesting the compatibility of the Sebag composition with higher fatty alcohols.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the shampoo composition of the combined references, which comprises silicone emulsion, by adding distearyl ether in the composition as motivated by Sebag, because the latter teaches that the compound renders insoluble silicone and detergent-containing foam compositions pearlescent effect, good homogeneity, and improved stability while maintaining foaming effect. The skilled artisan would have had a reasonable expectation of successfully producing silicone-containing shampoo compositions with pearlescent effect, good homogeneity with improved stability and foams.

#### **(10) Response to Argument**

I. Modification of Mitsumatsu in view of Oshima and Sebag to make the presently claimed composition would have been obvious to one of ordinary skill in the relevant art.

Appellant's statement that Mitsumatsu fails to teach or suggest the use of both a C18 fatty alcohol and a C22 fatty alcohol is inaccurate. Mitsumatsu teaches "[t]he fatty alcohols useful therein are those having from about 14 to about 30 carbon atoms, preferably from about 16 to about 22 carbon atoms. . . . Nonlimiting examples of fatty alcohols include, cetyl alcohol,

*stearyl alcohol, behenyl alcohol, and mixtures thereof*.” (emphasis mine) Sec p. 24, lines 16-20. Thus combining stearyl alcohol and behenyl alcohol in shampoo art would have been an obvious matter to a person of ordinary skill. Examples 4 and 5 also teaches C18 and C20 alcohols used in a mixture in 1:1 and 1:2 ratio, suggesting a modification in the weight amount and ratio of the fatty alcohols.

Although Mitsumatsu fails to disclose a specifically exemplified formulation comprising stearyl alcohol and behenyl alcohol in the appellant’s claimed ratios, the reference teaches and suggests that these two art-recognized hair conditioners can be used as a mixture in a shampoo formulation. Since Oshima teaches a specific ratio of the fatty alcohols that produces a beautiful appearance, pearl luster and excellent hair-conditioning effect on hair, a skilled artisan obviously had sufficient motivation to apply the amount and ratio of the Oshima’s C18 and C22 fatty alcohols to modify the Mitsumatsu teachings with a reasonable expectation of success in producing a stable shampoo with enhanced hair conditioning properties. Examiner asserts the presently claimed invention is an obvious modification of the cited references, and appellant’s arguments are unpersuasive to overcome the prima facie case of obviousness in this case, as further discussed in the following.

II. Appellant asserts Mitsumatsu fails to disclose the present invention and the proposed combination of Mitsumatsu and Oshima provides no expectation of success.

Appellant argues that reliance on the teachings of a *single* reference is not sufficient to establish an expectation of success. Appellant asserts that the expectation of success must relate to the proposed combination of references.

In this case, Oshima explicitly discloses a species of the genus recited in the present claim: the prior art's stearyl (C18) alcohol : behenyl (C22) alcohol ratio of 1:1.15-1:4.5 is equivalent to the ratio range of *0.2:1 to 0.9:1*. This ratio is well within the appellant's range of from *0.15:1 to 20:1* of claim 18; from *0.2 to 20* in claim 32; from *0.25 to 10* in claim 33; and finally, from *0.3 to 5* in claim 34. The prior art also teaches using C18 alcohol in a range of from 0.5 to 5 wt % and C22 alcohol in a range of from 0.75 to 7.5 wt %, which also coincides with appellant's claimed weight amount of the same fatty alcohols.

Appellant essentially argues that such particular teachings of Oshima would not have taught a skilled artisan a reasonable expectation of success in applying this prior art ratio of the fatty alcohols in another shampoo formulation. The argument is unpersuasive. As indicated above, Mitsumatsu explicitly suggests a mixture of stearyl and behenyl alcohols can be used, and manipulation of the weight amount of a hair conditioning component to find an optimal range would have required only ordinary skill in the art. See In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Therefore, there is apparently no reason why a person of ordinary skill would have expected the Oshima's fatty alcohol ratio to fail in the Mitsumatus' shampoo formulation.

Regarding the declaration filed on December 1, 2008, applicant asserts the comparison data in the declaration shows unexpected results of the present invention. The declaration compares compositions having C18:C22 fatty alcohol ratios of 0.19 and 0.085, and shows that the viscosity of the invention at the 0.19 ratio is "less temperature dependent" than the viscosity of the comparative composition. The data does not reasonably represent the actual scope of the presently claimed ratios of from 0.15 to 20. Moreover, claims 32-34 require the fatty alcohol



ratios be greater than 0.19, thus applicant's data is clearly not commensurate with the scope of these claims.

Appellant argues that the predictability of the temperature dependency of the viscosities produced by the fatty alcohol ratios is "precisely the issue in the rejection of record". The Examiner respectfully disagrees. Appellant's discovery of the inferior property of the weight ratio that is already outside the prior art range does not make the utility of the same prior art ratio new or unobvious. Appellant's data does not change the fact that the Oshima ratio coincides with the appellant's own ratio.

Examiner asserts the viscosity differences at 0.018 and 0.19 ratios as shown in the declaration is not commensurate with the scope of the claims and fails to overcome the obviousness of using the Oshima's C18:C22 fatty alcohol ratio, *0.2:1 to 0.9:1*, in modifying the Mitsumatsu's shampoo formulation. Since Mitsumatsu already teaches the same fatty alcohols as art-recognized hair conditioning components useful in shampoo art, a person of ordinary skill would have reasonably expected success in applying to the Mitsumatsu composition the weight amount and ratio of the fatty alcohols as taught, suggested and motivated by Oshima.

III. Sebag would have taught, suggested, and motivated a skilled artisan to combine the opacifier/pearlescent agent of the instant claims with the C18 and C22 fatty alcohols.

Appellant asserts that Sebag fails to teach any form of stearyl alcohol. Appellant argues that the reference only teaches cetylstearyl alcohol and stearyl alcohol oxyethylenated with ethylene oxide.

However, concurrently using stearyl and behenyl alcohols to formulate a shampoo is already found prima facie obvious in view of Mitsumatsu and Oshima. Sebag has been cited to

show the opacifier/pearlescent of the instant claims already had been known in shampoo formulation art before the time of the present invention. In the above rejection, the purpose of discussing stearyl alcohol used in Sebag's Example 1 was made to point out that a person of ordinary skill would have obviously recognized compatibility of distearyl ether and stearyl alcohol which have the same length of alkyl chain and used these components in a same composition.

In response to appellant's arguments here, a person of ordinary skill in the art would have obviously recognized that cetylstearyl alcohol, as the name indicates, is a mixture of cetyl alcohol and *stearyl alcohol*. The concurrent use of stearyl alcohol with distearyl ether has been already demonstrated in the prior art, and it would have been obvious to a person of ordinary skill in the art to combine the components of the present invention with a reasonable expectation of success in producing a stable shampoo formulation which imparts pearlescent effect, good homogeneity, and improved stability while maintaining foaming power as well as good hair conditioning properties.

For these reasons, examiner respectfully submits that the obviousness rejection of record has been properly made.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/GINA C. YU/  
Primary Examiner, Art Unit 1611

Conferees:

/David J Blanchard/  
Primary Examiner, Art Unit 1643

/Kay Kim/  
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